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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/329,461	06/10/1999	HERMAN RODRIGUEZ	AT9-99-085	8120

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EXAMINER

NGUYEN, CUONG H

ART UNIT PAPER NUMBER

3625

DATE MAILED: 01/29/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.  
**09/329,461**

Applicant(s)  
**Rodriguez et al..**

Examiner  
**Cuong H. Nguyen**

Art Unit  
**3625**



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on Dec 4, 2002
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 3, 4, 27, and 28 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 3, 4, 27, and 28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

### Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: \_\_\_\_\_

### **Status of the Claims**

1. Applicants have cancelled claims 1, 2, 5-14, 25-26, and 29-46 in the amendment filed on 12/04/02. An Supplemental Appeal Brief was also filed on 12/09/02, however, due to the new grounds of rejection presented below, prosecution has been reopened and remaining claims 3, 4, 27 and 28 will be examined on their merits in this Office action.

### **Response to Applicant's Arguments**

2. In response to applicants' arguments regarding the reference to Tognazzini, the examiner agrees that Tognazzini is primarily concerned with providing digital signatures via email to the customer and reporting/tracking expenses. This in and of itself however does not limit the teachings of Tognazzini, and it is the examiner's position that Tognazzini also teaches the specific claim limitations as detailed below. Applicant also argues that the instant invention is claiming "a specific arrangement" of steps "that provide advantages that were not previously available". Tognazzini also teaches this claimed arrangement of steps. Moreover, it is the examiner's position that Tognazzini does teach "updating an inventory" by producing reports that summarize at least some of the electronic receipt transactions (col. 6, lines 55-67; col. 2, lines 64 and 65). By formulating an expense report and updating accounting records as disclosed by Tognazzini in col. 2,

lines 64 and 65, an inventory of the transaction activity/history is inherently accomplished.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action: A person shall be entitled to a patent unless --

***(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.***

3. Claims 3-4, 27-28 are rejected under 35 U.S.C. 102(b) as being unpatentable over Tognazzini (US Pat. 5,739,512).

A. Regarding claims 3 and 4, Tognazzini teaches a method for processing electronic receipt for travel services (i.e. hotel, restaurant and rental car), using a computer which includes processing a purchase transaction (see col. 3, lines claim 5-11), generating an electronic receipt comprising data concerning the purchase transaction (col. 3, lines 21-26; col. 3, lines 34-36), storing and reading the electronic receipt on a movable storage medium (col. 3, lines 39-44 where "removable storage medium" equates to "computer program products" as taught by Tognazzini), validating the electronic receipt using a digital signature which is inspected for authenticity and integrity (col. 5, lines 1-10), and in response to validating the e-receipt, providing an indication to proceed with delivery of goods or

services related to the purchase transaction (col. 2, lines 35-40 i.e. the account is "debit(ed)" for the service), and updating an inventory affected by said delivery of goods or services (col. 6, lines 55-67; col. 2, lines 64-65, and 3:4-20, which disclose producing a report summarizing at least some of the receipts i.e. updating an inventory of activity).

B. Regarding claims 27 and 28, Tognazzini teaches a computer program product in a computer readable medium (col. 3, lines 39-45) for processing an electronic receipt (col. 2, lines 17-67). It is inherent that computer instructions are used to direct the computer to perform all of the actions/steps identified *supra*, and as specifically claimed in claims 27 and 28.

#### ***Conclusion***

4. All pending claims are rejected.

5. These references are also considered pertinent to this application:

- Business Wire, Feb 11, 1999; RPK Security Selected to Provide Encryption Solution for Electronic Payment Systems and Smart Card Readers. (claim 46)
- Digital signature reaches new level.(Bank of Nova Scotia uses Entrust Technologies' public key infrastructure software) (Company Operations); (Author: Greg Meckbach. Issue: June 22, 1998).

- **Trotta, Jr.**, (US Pat. 5,595,264), System and method for automated shopping - 1/21/1997; wherein a system and method of automated shopping, including a portable bar code scanner for scanning bar code indicia information on items selected to be purchased, securing the scanner in a holder for limited access, and releasing the portable bar code scanner upon receiving an authorized payment card. A plurality of items for purchase are displayed in a store such that a customer can select an item to be purchased from the store display. The customer scans the bar code indicia on the selected item from the store display. The payment card is debited for the purchase price of the selected item and then returned to the customer.

- **Kitagawa et al.** (US Pat. 6,032,857 - 8/23/1994) Electronic money system wherein an electronic money system has an IC card for electronic money having a memory for maintaining money deposit and money debit information and another memory, such as an EPROM, for storing transaction data, including detailed information of transactions, such as the content of a typical receipt received from a retail store. The transaction information can be used at a later time in a personal computer so that an electronic record of household expenses can be maintained The transaction data that is stored includes the product name, price of the product, quantity of the product purchased and similar details of the

transaction. The IC card memory can record the name and telephone number of a retail store where the card has been used or a network address can be recorded in the memory for use by a customer to access electronic direct-mail information by using a PC. Also, a store can determine whether a particular purchase is within a range of average purchases in terms of the number of products being purchased in a transaction and the total cost of the transaction, based on the stored transaction information.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cuong H. Nguyen whose telephone number is 703-305-4553. The examiner can normally be reached on Mon.-Fri. from 7:15 AM to 3:15 PM (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. Wynn Coggins, can be reached on (703) 308-1344.

Any response to this action should be mailed to:

Amendments

***Commissioner of Patents and Trademarks  
Washington D.C. 20231***

or faxed to:

(703) 305-7687 [Official communications; including  
After Final communications labeled "Box AF"]

703-746-5572 (RightFax) Informal/Draft communications,  
labeled "PROPOSED" or "DRAFT"]

09/329,461  
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Hand delivered responses should be brought to Crystal  
Park 5, 2451 Crystal Drive, Arlington, VA, 7<sup>th</sup> floor  
receptionist.

Any inquiry of a general nature or relating to the status of  
this application or proceeding should be directed to the  
Receptionist whose telephone number is (703)308-1113.

*Cuong Nguyen*  
Primary Examiner  
Jan. 27, 2003